



PATENT

Customer Number: 22,852
Attorney Docket No. 5725.0853-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Isabelle BARA

Application No.: 09/763,084

Filed: April 6, 2001

For: SOLID AQUEOUS GEL
COMPRISING A HYDROPHILIC
GELLING AGENT AND
POLYETHYLENE GLYCOL,
AND METHOD OF USING
SAME

Group Art Unit: 1712

Examiner: D. METZMAIER

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENT

In response to the Restriction and Election of Species Requirement dated August 14, 2002, reconsideration of the Requirement in view of the following remarks is respectfully requested.

In the Restriction and Election of Species Requirement, the Office has required restriction under 35 U.S.C. §§ 121 and 372 between the following groups of claims:

- I. Claims 1 and 26-86, drawn to a solid aqueous gel; and
- II. Claims 87 and 88, drawn to a method of making up.

In response, Applicants elect Group I, claims 1 and 26-86, with traverse.

Additionally, the Office has required an election of species. In particular, the Office has required an election of a hydrophilic gelling agent.

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As to the species, Applicants elect gellan gum. At least claims 1, 26, 28, 31, and 35-88 read on the elected invention.

Applicants submit that the Restriction Requirement is inappropriate in this case. Importantly, since this application is the national stage of a PCT application filed under 35 U.S.C. § 371, unity of invention rules apply.

As recognized by the Examiner, when the PTO considers international applications during the national stage under 35 U.S.C. § 371, PCT Rules 13.1 and 13.2 will be followed when considering the unity of invention of claims of different categories without regard to the practice in national applications filed under 35 U.S.C. § 111.

According to PCT Rule 13.2, unity of invention exists when there is a technical relationship among the claimed inventions involving one or more technical features. Specifically, M.P.E.P. § 1850 states that PCT Rule 13 shall be construed as permitting inclusion in the same application of "an independent claim for a given product" with "an independent claim for a use of the said product"

Under the facts of the present case, Example 1 of the PCT Administrative Instructions is particularly relevant:

Claim 1: A method of manufacturing chemical substance X.

Claim 2: Substance X.

Claim 3: The use of substance X as an insecticide.

Unity exists between claim 1, 2, and 3. The special technical feature common to all the claims is substance X.

Administrative Instructions under the PCT, Annex B, Part 2.

In the present case, the claims of Group I recite a solid aqueous gel, and the method claims of Group II involve a use for the solid aqueous gel. Unity exists between Groups I and II, **because the special technical feature common to all the claims is the solid aqueous gel.** See *id.* Since the present Restriction Requirement involves restricting between claims for a given product and method claims for the use of the product, the claims should be examined in the same application, as required by M.P.E.P. § 1850(C). Thus, the Restriction Requirement should be withdrawn.

The Office asserts that U.S. Patent No. 5,286,755 to Kauffman et al. (hereafter, "*Kauffman*") teaches "the formation of aqueous gels reading on claim 26" and "is evidence that the invention is not a contribution over the art when considered as a whole as claimed." Restriction Requirement at page 2. According to the Office, *Kauffman* "shows that not all hydrophilic gelling agents are equally useful since Kauffman et al. uses the further propylene glycol alginate as a hydrophilic gelling agent in combination with a suitable polyethylene glycol." *Id.* at 4.

In response, Applicants note that *Kauffman* is not being used to reject the present invention. Applicants submit that the present invention is a contribution to the art over *Kauffman*, such that the Restriction Requirement should be withdrawn.

Further, Applicants traverse both the Restriction and Election of Species Requirement on the grounds that the Office has not shown that there would be a serious burden to examine all of the pending claims together. In fact, the Office has failed to even state that any such burden exists. Accordingly, Applicant respectfully

submits that the Restriction and Election of Species Requirement is improper, and requests that it be withdrawn.

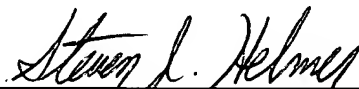
Finally, if the elected species is found allowable, Applicants expect the Examiner to extend the search to a reasonable number of the non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121. Applicants also respectfully remind the Examiner that if a generic claim is found to be allowable, the claims of the nonelected species should be examined if they depend from or otherwise include each of the limitations of the allowed generic claim. See M.P.E.P. § 809.02(c).

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: September 16, 2002

By: 
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